



ATTORNEY DOCKET NO. 040894-7204

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Confirmation No.: 9611
)	
Inventors: Yoko MATSUZAWA, et al.)	
)	
Application No.: 10/530,198)	Group Art Unit: 1654
)	
Filed: April 4, 2005)	
)	Examiner: Maury A. Audet
For: FINE SPHERICAL PARTICLES WITH)	
SATISFACTORY MOLECULAR)	
ORIENTATION, SPHERICAL MICRO-)	
CAPSULES COMPRISING THE SAME,)	
AND PROCESSES FOR PRODUCING)	
THESE)	

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Customer Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

RESPONSE TO EXAMINER'S COMMUNICATION MAILED NOVEMBER 14, 2006

Applicants respectfully request examination of the claims as amended in the May 3, 2006 Amendment and Response for the reasons that follow.

It is noted that in the Final Office Action mailed on July 27, 2006, the Examiner stated that the Applicants substantive amendment to claim 1 was not entered because it was "drawn to a new limitation which was not originally presented or searched." The Examiner further stated that "[t]herefore, a new search, beyond that originally conducted over the originally filed claims would be necessary in order to search the prior art for these new limitations." Claims 1-3 were thus examined only as originally presented. Applicants respectfully submit that the Examiner did not have the authority to refuse to examine the amended claims.

Upon telephone contact, the Examiner's indicated that this final rejection was sent in error. See Interview Summary, dated November 13, 2006. On November 14, 2006, a communication was mailed indicating that the Amendment and Response of May 3, 2006 was non-responsive. The reasons given reiterated the position with respect to amendment of claim 1.

Applicants respectfully submit that they filed, on May 3, 2006, a Response and Amendment in response to a non-final Office Action in compliance with 35 U.S.C. § 132(a) and 37 C.F.R. § 1.111. 35 U.S.C. § 132(a) states that "[w]henver, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection . . . and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined."

In this case, the Examiner has refused to examine an amendment because "a new search, beyond that originally conducted over the originally filed claims, would be necessary in order to search the prior art for these new limitations." While this may be an appropriate consideration in amendments after a final rejection, the requirement of a new search is irrelevant to an amendment before the Office has taken a final action. In fact, the amendment to claim 1 simply eliminates one sub genus from those originally presented (*i.e.*, when R is a hydrogen atom, m is not 1). That the Examiner may not have searched all of the possible limitations of original claim 1 is a result of an exercise of judgment within the purview of the Examiner. However, the applicant cannot be unduly penalized for this decision of the Examiner's.

Accordingly, applicants respectfully request that the communication of Nov. 14, 2006 be withdrawn and that the claims be reexamined as amended. Applicants, moreover, request that Office delay should be calculated from September 3, 2006, four months after the May 3, 2006 filing of the Amendment and Response, until the mailing date of a next Office Action, for the purposes of a Patent Term Guaranty.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: December 13, 2006

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